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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/556,357	10/17/2006	Hiroshi Hasegawa	050719	2301
23850 7590 04/21/2009 KRATZ, QUINTOS & HANSON, LLP 1420 K Street, N.W. Suite 400 WASHINGTON, DC 20005				
EXAMINER				
TRIEU, THERESA				
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3748				
MAIL DATE		DELIVERY MODE		
04/21/2009		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/556,357

**Applicant(s)**

HASEGAWA ET AL.

**Examiner**

Theresa Trieu

**Art Unit**

3748

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on Jan. 29, 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 7-12 and 20-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 7-12 and 20-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01/29/2009 & 11/10/2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

This Office Action is responsive to the applicants' amendment filed on Jan. 29, 2009.

Claims 1-6, 13-19 and 23 and have been withdrawn. Claim 7 has been amended. Accordingly, claims 7-12 and 20-22 are pending in this application.

#### ***Drawings***

1. The drawings were received on Jan. 29, 2009. These drawings are acceptable.

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

2. Claims 7-10 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Asanuma et al. (Asanuma) (Patent Number 4,762,471) in view of legal precedent.

Regarding claim 7, Asanuma discloses a compressor comprising: a container 1; a compression mechanism 8 disposed in a lower portion of the container; a rotational motor 4

disposed in an upper portion of the container, the rotational motor having a stator 2 and a rotor 3; a coil end (not numbered; however, clearly seen in Fig. 1) provided on each of upper and lower ends of the stator; a discharge pipe 10 provided on an upper end of the container; an oil reservoir 12 provided in a lower portion of the container; and a gap 3a provided between the rotational motor 4 and the container 1, the gap being operable to introduce working fluid, which is compressed by the compression mechanism, into an upper space of the container; and a substantially cylindrical dividing member 15 provided in the upper space of the container and being operable to divide the upper space into an inner space and an outer space (see Fig. 1); a second gap 19 provided between the stator and the rotor and communicating with the inner space of the dividing member 15, the second gap being operable to return oil to the oil reservoir 12; wherein the discharge pipe has an open end in the container 1, the open end being located inside the substantially cylindrical dividing member; and wherein the working fluid is discharged from the container through the discharge pipe 10. However, Asanuma fails to disclose a position of a second gap with respect to the diving member.

It would have been obvious to one having ordinary skill in the art at the time the invention was made, to have utilized a second gap being inside of the diving member, since the second gap would have performed equally well on inside of the dividing member and the mere repositioning of parts not effecting the functioning of the device involves only routine skill in the art, *In re Japikse*, 86 USPQ 70.

Regarding claims 8-10 and 20, Asanuma further discloses a gap is provided between an upper end of the dividing member 15 and the container 1; the dividing member 15 is provided with a communication hole (not numbered; however, clearly seen in Fig. 1) between the inner

space and the outer space; the dividing member 15 is provided inside the coil end provided on the upper end of the stator 2; an upper portion of the container 1 is domical in shape.

3. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Asanuma in view of legal precedent.

Asanuma discloses the invention as recited above; however, Asanuma fails to disclose a position of the dividing member with respect to the coil end. It would have been obvious to one having ordinary skill in the art at the time the invention was made, to have utilized the dividing member being provided outside the coil end provided on the upper end of the stator, since the dividing member would have performed equally well on inside/outside the coil end and the mere repositioning of parts not effecting the functioning of the device involves only routine skill in the art, *In re Japikse*, 86 USPQ 70.

4. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Asanuma in view of legal precedent.

Asanuma discloses the invention as recited above; however, Asanuma fails to disclose a shape of the dividing member. It would have been an obvious matter of design choice to have utilized an inner diameter of an upper portion of the dividing member is smaller than an inner diameter of a lower portion of the dividing member, since it has been held that a change in the shape of the element involves only routine skill in the art. *In re Dailey*, 149 USPQ 47 (CCPA 1966) (see MPEP §2144.04).

5. Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Asanuma in view of legal precedent as applied to claim 7 above, and further in view of Kawabe.

The modified Asanuma discloses the invention as recited above; however, the modified Asanuma fails to disclose a position of a cluster with respect to the rotational motor.

Kawabe teaches that it is conventional in the art to configure utilize an introduction terminal (D) provided in said container 1 and being operable to supply electricity to said rotational motor 11; and a cluster (see Figs. 1 or 5) adapted to connect a lead wire from the rotational motor to the introduction terminal. It would have been obvious to one having ordinary skill in the art at the time the invention was made, to have utilized a cluster adapted to connect a lead wire from the rotational motor to the introduction terminal, wherein the cluster is symmetric with respect to a center axis thereof, the center axis being substantially coincident with a rotation center axis of the rotational motor, since the cluster would have performed equally well and the mere repositioning of parts not effecting the functioning of the device involves only routine skill in the art, *In re Japikse*, 86 USPQ 70.

6. Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Asanuma in view of legal precedent as applied to claim 7 above, and further of Yamasaki et al. (Yamasaki) (Patent Number 6,732,542).

The modified Asanuma discloses the invention as recited above; however, the modified Asanuma fails to disclose a working fluid used carbon dioxide.

Yamasaki teaches that it is conventional in the art to utilize carbon dioxide is used as the working fluid (see col. 12, lines 43-48). It would have been obvious to one having ordinary skill in the art at the time the invention was made, to have utilized the carbon dioxide, as taught by

Yamasaki in the modified Asanuma apparatus, since the use thereof would have provided gentle to the earth and less flammable and toxic.

***Response to Arguments***

7. Applicants' arguments with respect to claims 7-12 and 20-22 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

9. Applicant is duly reminded that a complete response must satisfy the requirements of 37 C.F.R. 1.111, including: "The reply must present arguments pointing out the specific distinctions believed to render the claims, including any newly presented claims, patentable over any applied references. A general allegation that the claims "define a patentable invention" without specifically pointing out how the language of the claims patentably distinguishes them from the references does not comply with the requirements of this section. Moreover, "The prompt

development of a clear Issue requires that the replies of the applicant meet the objections to and rejections of the claims.” Applicant should also specifically point out the support for any amendments made to the disclosure. See MPEP §2163.06 II(A), MPEP §2163.06 and MPEP §714.02. The "disclosure" includes the claims, the specification and the drawings.

### ***Communication***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Theresa Trieu whose telephone number is 571-272-4868. The examiner can normally be reached on Monday-Friday 8:30am- 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas E. Denion can be reached on 571-272-4859. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

TT

/Theresa Trieu/  
Primary Examiner, Art Unit 3748